

REMARKS

At the outset, Applicant wishes to thank the Examiner for the courtesies that she extended in granting and conducting a telephonic interview with Applicant's representatives, Natalie Derzko and Barry Jacobsen, on August 23, 2007. During the interview, Applicant's representatives discussed a proposed approach for responding to the outstanding Non-Final Office Action. The Examiner appears to be favorably inclined toward this approach.

The Office Action of August 2, 2007 acknowledges Applicant's election with traverse of Group II (claims 72-120) and Applicant's election with traverse of species (c), drawn to a method of treating the nasal and non-nasal symptoms of perennial or seasonal allergic rhinitis, and makes the Restriction/Election of Species Requirement final. Consequently, claims 42-71, 97-98 and 110-115 have been withdrawn by the Examiner.

Status of Claims

Claims 1-41, 85-88 and 91-92 have previously been cancelled, without prejudice to or disclaimer of the subject matter recited therein. Claims 42-72, 74, 76-79, 82-84, 89, 97, 98, 100, 102-104 and 110-116 have additionally been cancelled in this Amendment, also without prejudice to or disclaimer of the subject matter recited therein. Claims 73, 75, 80, 81, 90, 93-96, 99, 101, 105-109, 117-121 are currently pending, with claims 73, 75, 80, 81, 90, 93, 95, 101, 105, 106 and 108 being independent. Each of claims 73, 75, 80, 81, 90, 101 and 105 has been rewritten in independent form containing all of the limitations of the base claim from which it previously depended. Moreover, claims 99, 117 and 118 have been amended to depend from non-cancelled claims. Also, claim 121 has been newly added and is of the same form as claim 99. All such claim amendments have been made to more specifically define and distinctly claim Applicant's invention. Support for these various claim amendments can be found throughout the specification and in the originally filed claims. No new matter has been added by these amendments.

Nonstatutory Obviousness-Type Double Patenting

Claims 72-84, 89-90, 93-96, 99-109 and 116-120 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,709,676 to Cho in view of U.S. Patent No. 6,423,721 to Harris et al.

The Cho patent is the primary reference and conflicting patent in this nonstatutory double patenting rejection, whereas, the '721 Harris patent is the secondary reference. *See* page 5, line 12 of the Office Action. *See also* ¶ 804 MPEP, specifically form paragraphs 8.33 and 8.36. In view of this, the Office Action suggests, at page 4, lines 8-12, that a terminal disclaimer may be used to overcome this nonstatutory double patenting rejection if directed to the conflicting patent, namely, the Cho patent, provided that this application and the Cho patent are commonly owned, which indeed they are. During Applicant's telephonic interview on August 23, 2007, Examiner Sheikh confirmed that this rejection would be overcome if Applicant were to file a terminal disclaimer directed to the Cho patent. Accordingly, such a terminal disclaimer together with the appropriate fee is attached. Applicants respectfully submit that this nonstatutory double patenting rejection should, therefore, be withdrawn.

Obviousness Rejections

Claims 72-84, 89-90, 99-100, 102-105 and 116-118 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,114,346 to Harris et al. Moreover, claims 93-96, 101, 106-109 and 119-120 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the '346 Harris et al. patent as applied to claims 72-84, 89-90, 99-100, 102-105 and 116-118, as noted above, in view of the '721 Harris et al. patent and further in view of U.S. Patent No. 6,372,802 to Hellberg et al.

In each of these obviousness rejections, the '346 Harris et al. patent is relied upon as the primary reference. However, as acknowledged at page 7 of the Office Action, the '346 Harris et al. patent could only qualify as prior art as against the present application under 35 U.S.C. §102(e). Moreover, like the present application, the '346 Harris et al. patent is assigned to Schering Corporation and was so assigned at the time that the claimed invention in the present application was made. That is, this application and the '346 Harris et al. patent were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely, Schering Corporation. Consequently, pursuant to 35 U.S.C. § 103(c), the '346 Harris et al. patent cannot preclude patentability of the claimed invention. During Applicant's telephonic interview on August 23, 2007, Examiner Sheikh agreed that a statement of common ownership pursuant to 35 U.S.C. §103(c) would dispose of both obviousness rejections. Accordingly, Applicants respectfully submit that these rejections

should be withdrawn.

Anticipation Rejections

Claims 72, 74, 76, 77, 79, 82, 83, 89, 99, 102-104, 117 and 118 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,731,319 to Aberg, et al. Also, claims 72, 74, 76-79, 82-84, 89, 99, 100, 102-104 and 116-118 have been rejected under 35 U.S.C. §102(e) as being anticipated by the '346 Harris et al. patent.

All the claims that have been rejected as anticipated, namely claims 72, 74, 76-79, 82-84, 89, 100, 102-104 and 116, have been cancelled, without prejudice to or disclaimer of the subject matter recited therein, except for claims 99, 117 and 118. Moreover, the dependency of each of claims 99, 117 and 118 has been amended so as not to depend from cancelled claims, i.e., respectively, claims 72, 102 or 103. Consequently, Applicant respectfully submits that both anticipation rejections are now moot and should be withdrawn. In a telephonic interview on August 23, 2007, the Examiner agreed that cancellation of the claims rejected under 35 U.S.C. §102 and adjustment of various claim dependencies so as not to rely on previously rejected claims would dispose of both anticipation rejections in the Office Action.

In view of the above, Applicant submits that the remaining pending claims are in condition for allowance and requests reconsideration and withdrawal of each of the rejections in the Office Action. The Examiner is respectfully requested to pass this application to issue. Applicant further requests that the Examiner contact Applicant's undersigned representative should there be any remaining issues precluding allowance of this application.

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Respectfully submitted,

By

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